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JUN 21 2004

OFFICE OF PETITIONS

In re Application of :
Dobrowolski :
Application No. 10/715,087 : DECISION ON PETITIONS
Filed: September 25, 2001 :
Attorney Docket No. A01588US :
For: SURFACTANT-CONTAINING :
INSULATION BINDER :
:

This is a decision on the petition titled, "PETITION UNDER 37 CFR 1.47(a) & 1.181," filed June 15, 2004. The petition will be treated (1) under 37 CFR 1.47(a) for accordation of Rule 47 status to the above-identified application, (2) under 37 CFR 1.48(a) to amend the inventorship by the addition of Liang Chen, Jay W. Hinze, and William G. Hager, and (3) under 37 CFR 1.183 to waive the requirements of 37 CFR 1.48(a)(2), which requires each inventor being added to submit a lack of deceptive intent statement and 1.48(a)(3), which requires each inventor to execute the declaration.

The petition under 37 CFR 1.47(a) is dismissed.

The petition under 37 CFR 1.48(a) to amend the inventive entity is dismissed.

The petition under 37 CFR 1.183 to waive 37 CFR 1.48(a)(2) and 1.48(a)(3) is granted.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a) and 1.48(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The first declaration, filed on March 8, 2004 set the inventive entity as Richard Dobrowolski. The instant petition was filed on June 15, 2004 and seeks to add three more inventors – Liang Chen, Jay W. Hinze, and William G. Hager – and obtain Rule 47 status based on their refusal to sign the declaration. However, once the inventive entity has been set by an initial declaration, a

petition under 37 CFR 1.48 is required to change it.

Therefore, the instant petition will be treated under 37 CFR 1.47(a), under 37 CFR 1.48(a), and under 37 CFR 1.183 to waive 37 CFR 1.48(a)(2) and 1.48(a)(3).

PETITION UNDER 37 CFR 1.47(a)

The above-identified application was filed on November 17, 2003 without an executed oath or declaration. Accordingly, on February 12, 2004, a "Notice to File Missing Parts of Nonprovisional Application" was mailed, requiring, *inter alia*, an executed oath or declaration and a surcharge for its late filing. In response, petitioners submitted a declaration executed by Richard Dobrowolski on March 8, 2004.

Petitioners filed a petition under 37 CFR 1.47(a) on June 15, 2004. The petition signed by Attorney Robert W. Stevenson and accompanying exhibits establish that the legal representative of the non-signing joint inventors, Inger H. Eckert, was mailed and received a copy of the application and a declaration for the above-identified application, but Ms. Eckert, on behalf of her clients, expressly refused to sign the declaration.

A grantable petition under 37 CFR 1.47(a) requires

- (1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,
- (2) a proper oath or Declaration executed by the available joint inventor(s),
- (3) the fee of \$130 as specified in 37 CFR § 1.17(h), and
- (4) the last known address of the omitted inventor(s).

This petition lacks item (2) above.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 still has not been presented. The declaration is not acceptable because it only lists Mr. Dobrowolski as an inventor. Information for all inventors must be listed on a new declaration. This information includes: Given Name(s); Family Name, Residence, Citizenship, and Mailing Address. Mr. Dobrowolski must execute the new declaration. The non-signing inventors signature blocks should be left blank.

Pursuant to petitioners' authorization, deposit account no. 18-1850 will be charged a \$130.00 petition fee for filing a petition under 37 CFR 1.47(a).

The petition under 37 CFR 1.47(a) is **dismissed**.

**PETITION UNDER 37 CFR 1.48(a) & PETITION UNDER 37 CFR 1.183 TO WAIVE
37 CFR 1.48(a)(2) and 1.48(a)(3)**

37 CFR 1.48(a) requires that an amendment to the named inventive entity be accompanied by: (1) a request to correct the inventorship that sets forth the desired inventorship change; (2) a statement from *each person being added* and from each person being deleted as an inventor that the error occurred without deceptive intention on his or her part; (3) an oath or declaration by each actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47; (4) the fee set forth in 37 CFR 1.17 (i); and (5) the written consent of any existing assignee, if any of the originally named inventors has executed an assignment.

Petitioners have established that the non-signing inventors, through their attorney, have refused to execute the declaration for patent application. Petitioners have shown (1) that this is an extraordinary situation where (2) justice requires waiver of the rules. *In re Sivertz*, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985).

The petition under 37 CFR 1.183 to waive 37 CFR 1.48(a)(2) and 1.48(a)(3) is **granted**.

Petitioners should not be required to obtain the non-signing inventors' cooperation. However, petitioners have not satisfied the requirements of 37 CFR 1.48(a)(3) because the declaration itself is flawed. As stated above in the Rule 47 portion of this decision, the declaration fails to include identifying information for all joint inventors.

In addition, if Mr. Dobrowolski has executed an assignment to Rohm Haas Company, an individual with proper authority should provide written consent to the requested correction in inventorship. Please clarify in any reconsideration petition whether or not there is an assignee of the invention.

The petition under 37 CFR 1.48(a) is **dismissed**.

Once petitioners submit an acceptable declaration and clarify the assignee existence issue, the petition under 37 CFR 1.48(a) and the petition under 37 CFR 1.47(a) will be granted.

Pursuant to petitioners' authorization, deposit account no. 18-1850 will be charged a \$130 petition fee for filing a petition under 37 CFR 1.48 and a \$130.00 petition fee for filing a petition under 37 CFR 1.183 to waive 37 CFR 1.48(a)(2) and (a)(3).

Further correspondence with respect to this matter should be addressed as follows:

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